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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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Jonathan S. Spirgel

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EXAMINER

FIELDS, BENJAMIN S

ART UNIT

PAPER NUMBER

3692

MAIL DATE

DELIVERY MODE

10/28/2008

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/680,589	<b>Applicant(s)</b> SPIRGEL ET AL.	
	<b>Examiner</b> BENJAMIN S. FIELDS	<b>Art Unit</b> 3692	

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 16 July 2008.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-72 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-72 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                     | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)          | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____  | 6) <input type="checkbox"/> Other: _____                          |

## DETAILED ACTION

### *Introduction*

1. The following is a **NON-FINAL** Office Action in response to the communication received on 16 July 2008. Claims 1-72 are now pending in this application.

### *Response to Amendments*

2. The Examiner acknowledges the Applicants amendment of the Specification for the purposes of clarity.

3. The Examiner acknowledges the Applicants comments regarding the originally asserted Double Patenting Rejection. The Double Patenting Rejection was in fact a **non-statutory** type rejection and ***not** a statutory type rejection*. However, based on Applicants amendment, the originally asserted Double Patenting Rejection has been removed.

4. The Examiner acknowledges the Applicants submission of a Terminal Disclaimer in regards copending application 11/236,863. Subsequently, entry of this Terminal Disclaimer is being provided as requested.

5. Applicants Amendments to Claims 1-72 has been acknowledged in that: **NO Claims have been cancelled; Claims 2-4, 12-14, 19-25, 31-36, 38-39, 42-47, 54, 61, and 66-69 have been amended; NO Claims have been added;** hence, as such, **Claims 1-72 are pending within this application.**

***Claim Rejections - 35 USC § 101***

6. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

7. Claims **1** and **70** are rejected under 35 U.S.C. 101 because the claimed invention is not directed to a secondary statutory subject matter/class.

Based on Supreme Court precedent [*See Diamond v. Diehr*, 450 U.S. 175, 184 (1981); *Parker v. Flook*, 437 U.S. 584, 588 n.9 (1978); *Gottschalk v. Benson*, 409 U.S. 63, 70 (1972); *Cochrane v. Deener*, 94 U.S. 780, 787-88 (1876)] and recent Federal Circuit decisions, § 101 methods/processes must (1) be tied to another statutory class (such as a particular apparatus) or (2) transform underlying subject matter (such as an article or materials) to a different state or thing [*The Supreme Court recognized that this test is not necessarily fixed or permanent and may evolve with technological advances. Gottschalk v. Benson*, 409 U.S. 63, 71 (1972)]. If neither of these requirements is met by the claim(s), the method is not a patent eligible process under 35 U.S.C. § 101.

***Claim Rejections - 35 USC § 103***

8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claims 1-6, 9-27, 29-36, 38-48, 50-57, 59-61, and 63-72 are rejected under 35 U.S.C. 103(a) as being unpatentable over Annunziata (US PG Pub. No. 2001/0034688), [hereinafter Annunziata].

Referring to Claim 1: Annunziata shows a method for creating shares in a commodity, comprising: receiving a [creation order] comprising a request to create commodity shares (Annunziata: Abstract; Figures 1-2; Page 1, Paragraphs 0007-0014; Page 2, Paragraphs 0026-0028; Page 5, Paragraph 0043) confirming delivery into an account of an amount of commodity associated with the commodity shares being requested (Annunziata: Abstract; Figures 1-3; Page 1, Paragraph 0014); and releasing the requested commodity shares based upon the amount of commodity delivered into the account (Annunziata: Abstract; Figures 1-3; Page 1, Paragraph 0014).

The Examiner notes that the Annunziata reference does not expressly utilize the term “creation order”. It should be noted, however, that although the Annunziata reference does not expressly show the term “creation order”, the obvious teaching of such is evident in that Annunziata discusses a system and method which is responsible for the creation of commodities, etc. (See at least Annunziata: Page 1, Paragraphs 0007-0014; Page 5, Paragraph 0043).

Referring to Claim 2: Annunziata discusses a method further comprising acknowledging receipt of the creation order (Annunziata: Page 2, Paragraph 0026-Page 3, Paragraph 0029).

Referring to Claim 3: Annunziata teaches a method further comprising sending a notice of pending commodity delivery to a custodian of the account (Annunziata: Page 2, Paragraph 0026-Page 3, Paragraph 0029).

Referring to Claim 4: Annunziata discloses a method further comprising confirming receipt of the notice of pending commodity delivery (Annunziata: Page 2, Paragraph 0026-Page 3, Paragraph 0029).

Referring to Claim 5: Annunziata shows a method, wherein the value of the shares released is approximately equal to the value of the commodity delivered into the account (Annunziata: Page 3, Paragraphs 0029-0031).

Referring to Claim 6: Annunziata teaches a method further comprising receiving a reconciliation from the custodian (Annunziata: Page 3, Paragraphs 0029-0033).

Referring to Claim 9: Annunziata discusses a method, wherein the creation order comprises a request to create of a minimum amount of shares or a multiple of the minimum amount (Annunziata: Page 3, Paragraph 0033-Page 4, Paragraph 0038).

Referring to Claim 10: Annunziata shows a method, wherein the value of the amount of commodity delivered into the account is not less than a minimum value (Annunziata: Page 3, Paragraph 0033-Page 4, Paragraph 0038).

Referring to Claims 11-18: Claims 11-18 parallel the limitations of Claims 1-6, and 9-10. As such, Claims 11-18 are rejected under the same basis as are Claims 1-6, and 9-10 as mentioned supra.

Referring to Claims 19-27 and 29: Claims 19-27 and 29 reflect the limitations of Claims 1-6, and 9-18. As such, Claims 19-27 and 29 are rejected under the same basis as are Claims 1-6, and 9-18 as mentioned supra.

Referring to Claims 30-36 and 38-40: Claims 30-36 and 38-40 parallel the limitations of Claims 1-6, and 9-18 in that they refer to the redemption of the shares created in the commodity. As such, Claims 30-36 and 38-40 are rejected under the same basis as are Claims 1-6, and 9-18 as mentioned supra.

Referring to Claims 41-48 and 50-52: Claims 41-48 and 50-52 reflect the limitations of Claims 30-36 and 38-40 in that they refer to the redemption of the shares created in the commodity. As such, 41-48 and 50-52 are rejected under the same basis as are Claims 30-36 and 38-40 as mentioned supra.

Referring to Claims 53-57 and 59: Claims 53-57 and 59 parallel the limitations of Claims 30-36, 38-48, and 50-52 in that they refer to the redemption of the shares created in the commodity. As such, Claims 53-57 and 59 are rejected under the same basis as are Claims 30-36, 38-48, and 50-52 as mentioned supra.

Referring to Claim 60: Claim 60 reflects the limitations of Claim 30. As such, Claim 60 is rejected under the same basis as is Claim 30 as mentioned supra.

Referring to Claims 61 and 63-69: Claims 61 and 63-69 reflect the limitations of Claims 30-36, 38-48, and 50-52. As such, Claims 61 and 63-69 are rejected under the same basis as are Claims 30-36, 38-48, and 50-52 as mentioned supra.

Referring to Claims 70-72: Claims 70-72 parallel the limitations of Claims 61 and 63-69. As such, Claims 70-72 are rejected under the same basis as are Claims 61 and 63-69 as mentioned supra.

8. Claims 7-8, 28, 37, 49, 58, and 62 are rejected under 35 U.S.C. 103(a) as being unpatentable over Annunziata in view of Turk (US Pat. No. 5,671,364), [hereinafter Turk].

Referring to Claim 7: Annunziata teaches the limitations of Claim 1.

Annunziata, however, does not expressly discuss a method, wherein the commodity delivered into the account is gold or gold receipts.

Turk, in a similar environment, shows a method, wherein the commodity delivered into the account is gold or gold receipts (Turk: Abstract; Column 2, Lines 26-67; Claim 2, 3, 9).

At the time of the invention it would have been obvious to one of ordinary skill in the art to modify the method of Annunziata for trading commodities with the invention of Turk for the purpose of utilizing various forms of deposit currency (Turk: Column 2, Lines 12-34).

Referring to Claim 8: Annunziata discloses the limitations of Claim 1.

Annunziata, however, does not expressly teach a method, wherein the value of the shares released is based on the net asset value of the received gold.



Turk, in a similar environment, shows a method, wherein the value of the shares released is based on the net asset value of the received gold (Turk: Abstract; Claims 1-9).

At the time of the invention it would have been obvious to one of ordinary skill in the art to modify the method of Annunziata for trading commodities with the invention of Turk for the purpose of utilizing various forms of deposit currency (Turk: Column 2, Lines 12-34).

Referring to Claims 28, 37, 49, and 58: Claims 28, 37, 49, and 58 reflect the limitations of Claim 7. As such, Claims 28, 37, 49, and 58 are rejected under the same basis as is Claim 7 as mentioned supra.

Referring to Claim 62: Annunziata shows the limitations of Claim 61.

Annunziata, however, does not expressly teach a method, wherein said commodity is gold or another precious metal.

Turk, in a similar environment, discusses a method, wherein said commodity is gold or another precious metal. (Turk: Abstract; Claims 1-9).

At the time of the invention it would have been obvious to one of ordinary skill in the art to modify the method of Annunziata for trading commodities with the invention of Turk for the purpose of utilizing various forms of deposit currency (Turk: Column 2, Lines 12-34).

### **Response to Arguments**

9. The Applicant's arguments filed 16 July 2008 have been fully considered but have been found to be **moot** and **non-persuasive** in view of the new grounds of rejection.

### **Examiner Note**

10. **The Examiner has pointed out particular reference(s) contained in the prior art of** record within the body of this action for convenience of the Applicant. Although the specified citations are representative of the teachings in the art and are applied to the specific limitations within the individual claim, other passages and figures may apply. **Applicant**, in preparing the response, should **fully consider the entire reference** as potentially teaching all or part of the claimed invention, as well as the context of the passage as taught by the prior art or disclosed by the Examiner.

### **Conclusion**

11. Any inquiry concerning this communication should be directed to BENJAMIN S. FIELDS at telephone number 571.272.9734. The examiner can normally be reached MONDAY THRU FRI between the hours of 9AM and 7PM. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, KAMBIZ ABDI can be reached at 571.272.6702. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Art Unit: 3692

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Benjamin S. Fields

16 October 2008

/Harish T Dass/

Primary Examiner, Art Unit 3692